

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-22 and 26-34 are pending in the application, with claims 1, 6, 10, 16, 26, and 29-31 being the independent claims. Claims 26 and 29-31 are sought to be amended. New claims 32-34 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

The amendments should be entered after final rejection as they were suggested by the Examiner during the below-mentioned interview, they do not require further search or consideration, and they place the application in condition for allowance and/or better condition for appeal.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

***Telephone Interview Held March 4, 2010***

Applicant would like to thank the Examiner for the telephone interview held on March 4, 2010 between the Examiner and Applicant's representative. During the interview, the parties discussed the outstanding rejections under 35 U.S.C. §§ 101 and 103(a).

The Examiner indicated that the rejection under 35 U.S.C. § 101 would be overcome by amending independent claims 26 and 29-31 to recite a "non-transitory" medium. It is noted that the Applicant has agreed to amend claims 26 and 29-31 in this

manner only to expedite prosecution of this matter, and that the Applicant does not intend to exclude memory (whether semiconductor-based or magnetic media-based) from the scope of claims 26 and 29-31.

The Examiner further agreed that this amendment would be entered after final rejection in order to better place the claims in condition for appeal, if necessary. However, Applicant presents additional claim amendments herein that were not discussed during the interview in order to better place the claims in condition for appeal, and consideration and entry thereof after Final is also respectfully requested.

The parties discussed the rejection under 35 U.S.C. § 103(a) with regard to the Richards reference. The Examiner and Applicant's representative offered alternative, conflicting viewpoints of the Richards disclosure. No agreement was reached regarding Richards, nor for any potential claim amendments that would serve to overcome the rejection.

The Examiner is invited to contact the undersigned should any further amendments or clarifications be requested in order to place the claims in condition for allowance.

***Rejection under 35 U.S.C. § 101***

The Examiner has rejected claims 26-31 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses. Without acquiescing to the propriety of the rejection, Independent claims 26 and 29-31 as clarified recite, *inter alia*, "[a] ***non-transitory*** tangible computer-readable medium." This language recites statutory subject matter, in accordance with the holding of *In re*

*Nuitjen*, 500 F.3d 1346 (Fed. Cir. 2007). Therefore, claims 26 and 29-31, as well as dependent claims 27 and 28, recite statutory subject matter.

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 26-31 under 35 U.S.C. § 101.

***Rejections under 35 U.S.C. § 103***

***Claims 1-5***

The Examiner has rejected claims 1-5 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,292,895 to Baltzley (“Baltzley”), in view of U.S. Patent No. 5,923,754 to Angelo *et al.* (“Angelo”) and U.S. Patent No. 6,603,857 to Batten-Carew *et al.* (“Batten-Carew”), and further in view of U.S. Patent Application Publication No. 2002/0016922 to Richards *et al.* (“Richards”). Applicant respectfully traverses this rejection, and the Response to Arguments section on pages 2-4 of the Final Office Action.

Claim 1 recites, *inter alia*, “wherein the ***header includes the document key and access rules*** for the secured electronic file, the access rules configured to further ***protect the document key***.” The Examiner has failed to establish a *prima facie* of obviousness with regard to at least this element. Baltzley, Angelo, and Batten-Carew do not teach or suggest, nor does the Examiner rely on these references to allegedly teach or suggest, at least the aforementioned features of claim 1. Instead, the Examiner relies on Richards as allegedly teaching or suggesting these features.

The Examiner argues in the "Response to Arguments" section of the Office Action that the aforementioned feature is found at paragraph [0023] of Richards, which

recites, "The method includes the steps of: authenticating a user, **encrypting of data with a security key**, generating a **dynamic key on a secure server and transferring the dynamic key** to a recipient device, and decrypting the data by the **security key based on the dynamic key transferred** with the data or transferred independently of the data." (Office Action, p. 3) (emphasis Examiner's). The Examiner argues that further support is found at paragraph [0067] of Richards, which recites, "**encryption/security key for accessing the database and other encrypted file data** is incorporated into one of **the elements of the header component 112**." (Office Action, p.4) (emphasis Examiner's).

The Examiner then argues that the "server keyed" element of Richards protects a "document key" by requiring retrieval of a dynamic key which is used to access the security key protecting encrypted file data. (Office Action, p. 4). Applicant does not acquiesce to this interpretation of Richards.

When a "server keyed" element is present in a header in Richards, it "requires the recipient to authenticate itself to the server and request opening of a file" and, in response, "[a] required key will be provided by the secure server." (Richards at [0068]). This key appears to be, in one embodiment, the dynamic key ("the dynamic key transferred with the data or transferred independently of the data", Richards at [0023]).

However, it is unclear that Richards keeps a security key in a header for decryption by a received dynamic key in order to support the Examiner's assertion that the "server keyed" element of Richards corresponds to "access rules configured to further *protect the document key*," as recited in claim 1.

Evidence exists throughout Richards to suggest that the key described as being located in the header (e.g., "transferred with the data") of Richards is the same key, and not an additional key, as the key that may alternatively be "transferred independently of the data." (Richards at [0023]). For example, Richards describes that "the header comprises a dynamic key" (Richards at [0152]). Richards further describes the behavior of this key:

[0158] The first key is global and dynamic and is *stored in the encoded header of the file*. This key dynamically generated by the secure server application for a user session and is always transmitted in a secure fashion using any standard or custom methodology to insure its security. Furthermore the dynamic key is stored only in random memory and never stored on a permanent storage medium.

As Richards only describes a single key ever being stored in a header (see, e.g., Richards at FIG. 4, element 112, "E\_Key"; "[o]ther information within the header comprises a dynamic key", Richards at [0152]), this key would therefore be the dynamic key described above as being stored in the header, and not a separate "security key" which is itself encrypted by the dynamic key, as argued by the Examiner.

It is noted that in paragraph 0158 of Richards, reprinted above, that the header storing the dynamic key is "encoded," and further that "[d]ata from the encoded header is decrypted" as part of the data decode process. (Richards at [0154]). However, there is no evidence anywhere in Richards that this decryption is in any way tied to the "server keyed" element, or any other element that can be said to correspond to "access rules configured to further *protect the document key*," as recited in claim 1.

The purpose of the "server keyed" element in Richards can be reasonably interpreted to be the provision of the *same* dynamic key, discussed above as being

located in the header (e.g., "transferred with the data"), directly from the server (e.g., "transferred independently of the data"). (Richards at [0023]).

In response to these arguments during the telephone interview of March 4, 2010, the Examiner appeared to argue that the "security key" described in paragraph [0023] of Richards was necessarily something different than the aforementioned dynamic key, arguing that "decrypting the data by the security key based on the dynamic key transferred with the data or transferred independently of the data" (Richards at [0023]) implied that the dynamic key was being retrieved in response to the "server keyed" element to decrypt the security key to in turn decrypt a file.

However, Applicant notes that Richard's use of the term "security key" does not imply this behavior. The "security key" is alternatively referred to by Richards as an "encryption/security key" (Richards at [0067]), and the "encryption key" may refer to one of multiple encryption keys (Richards at [0085]-[0090]) including "a *dynamic* public key that may be changed with each new session or block of encoded secured information sent by the secure server as a part of a secured session."

Moreover, the only key described directly in connection with decryption of a header, which may include the aforementioned dynamic key, is "a fixed *internal* or *private key accessible only by an internal code* used to open a header of the encoded data." (Richards at [0085]).

It is clear, therefore, that the "server keyed" element of Richards is not "configured to further protect the document key," "wherein the header includes the document key," as recited in claim 1. The "server keyed" element protects some key which is simply not found in the header of Richards. The only protection for an

encrypted header described in Richards comes from a purely internal private key, and cannot possibly refer to a key retrieved at the behest of the "server keyed" element.

As a result, Applicant respectfully asserts that the Examiner's statements regarding Richards improperly and impermissibly go beyond the disclosure of the reference and, rather than any evidence of record, find their basis only in speculation and impermissible hindsight. When determining whether a claim is obvious, an Examiner must make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Int'l. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

It appears the Examiner is relying on improper speculation of what the reference *may* be teaching. In an exemplary post-KSR BPAI decision, *Ex Parte Kamran Ahmed*, Appeal 2007-2765, App. 09/526,442, Decided Feb. 11, 1008 at page 6, the Board opined "Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. 'Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand.' (quoting *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967)). See also *In re Kahn*, 441 F.3d at 988." Also, on page 10 of *Ex Parte Ahmed*, the Board held the Examiner relied on improper speculation, and reversed the obviousness rejection. Finally, the Supreme Court also confirmed that, "[a] fact finder should be aware, of course, of the distinction caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007).

Accordingly, claim 1 is not rendered obvious by the combination of Baltzley, Angelo, Batten-Carew, and Richards. Claims 2-5 depend from claim 1, and are likewise not rendered obvious by the combination of Baltzley, Angelo, Batten-Carew, and Richards for at least the same reasons as claim 1, and further in view of their own respective features.

For at least the aforementioned reasons, the Office Action fails to establish a *prima facie* case of obviousness of claims 1-5. Applicant therefore respectfully requests the reconsideration and withdrawal of the rejection of claims 1-5 under 35 U.S.C. § 103(a).

**Claims 6-9 and 26-29**

The Examiner has rejected claims 6-9 and 26-29 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,892,306 to En-Seung *et al.* (“En-Seung”), in view of Richards and Batten-Carew, and further in view of U.S. Patent No. 6,851,050 to Singhal *et al.* (“Singhal”). Applicant respectfully traverses this rejection.

Claims 6, 26, and 29 recite analogous distinguishing features as discussed above with respect to claim 1, using respective language. En-Seung, Batten-Carew, and Singhal do not teach or suggest at least these distinguishing features of claims 6, 26, and 29, nor does the Examiner rely on them to allegedly teach or suggest at least these distinguishing features. Instead, the Examiner relies on Richards as allegedly teaching these distinguishing features. (Office Action, p. 13). For similar reasons as discussed above with regard to claim 1, Richards does not supply the missing teaching or suggestion.



Accordingly, the combination of En-Seung, Batten-Carew, Singhal, and Richards does not teach or suggest each and every feature of claims 6, 26, and 29, and therefore do not render the claims obvious. Claims 7-9 depend from claim 6, and claims 27 and 28 depend from claim 26, and are also not rendered obvious by the combination for at least the same reasons as claims 6 and 28, and further in view of their own respective features.

For at least the aforementioned reasons, the Office Action fails to establish a *prima facie* case of obviousness of claims 6-9 and 26-29. Applicant therefore respectfully requests the reconsideration and withdrawal of the rejection of claims 6-9 and 26-29 under 35 U.S.C. § 103(a).

**Claims 10-22, 30, and 31**

The Examiner has rejected claims 10-22, 30, and 31 under 35 U.S.C. § 103(a) as allegedly being obvious over En-Seung in view Richards and further in view of Batten-Carew. Applicant respectfully traverses this rejection.

Claims 10, 16, 30, and 31 recite distinguishing features analogous to the distinguishing features discussed above that are recited in claim 1, using respective language. En-Seung and Batten-Carew do not teach or suggest at least these distinguishing features of claims 10, 16, 30, and 31, nor does the Examiner rely on the references to allegedly teach or suggest at least these distinguishing features. Instead, the Examiner relies on Richards as allegedly teaching these distinguishing features. (Office Action, pp. 17 and 20). For similar reasons as discussed above with regard to claim 1, Richards does not supply the missing teaching or suggestion.

Accordingly, the combination of En-Seung, Batten-Carew, and Richards does not teach or suggest each and every feature of claims 10, 16, 30, and 31, and therefore do not render the claims obvious. Claims 11-15 depend from claim 10, and claims 17-22 depend from claim 16, and are also not rendered obvious by the combination for at least the same reasons as claims 10 and 16, and further in view of their own respective features.

For at least the aforementioned reasons, the Office Action fails to establish a *prima facie* case of obviousness of claims 10-22, 30, and 31. Applicant therefore respectfully requests the reconsideration and withdrawal of the rejection of claims 10-22, 30, and 31 under 35 U.S.C. § 103(a).

#### ***New Claims***

Applicant respectfully seeks entry of new claims 32-34. New claims 32-34 recite, *inter alia*, language sought to be deleted from claims 6, 26, and 29 in order to broaden those claims. Accordingly, for at least the same reasons as claims 6, 26, and 29 provided above based on their dependencies thereto, and further in view of their own respective features, Applicant respectfully requests the entry and allowance of claims 32-34.

Reply to Office Action of January 19, 2010

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***Conclusion***

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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